

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1-87 are now present in this application. Claims 1, 24, 31, 47, 60, 77 and 85 are independent.

Amendments have been made to the specification, and claims 1, 8, 10, 11, 12, 13, 14, 16, 20, 21, 23, 24, 27, 29, 30, 31, 35, 36, 37, 39, 43, 44, 46, 47, 51, 53, 56, 59, 60, 64, 67, 69, 70, 71, 72, 73, 75, 77, 78, 81, 82, 83, 85 and 86 have been amended. Reconsideration of this application, as amended, is respectfully requested.

Priority Under 35 U.S.C. § 119

Applicant thanks the Examiner for acknowledging Applicant's claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

Information Disclosure Citation

Applicant thanks the Examiner for considering the reference supplied with the Information Disclosure Statement filed November 6, 2001, and for providing Applicant with an initialed copy of the PTO-1449 form filed therewith.

Claim Objections

The Examiner has objected to claims **46 and 77** because of several informalities. In order to overcome this objection, Applicant has amended claims 46 and 77 in order to correct the deficiencies pointed out by the Examiner. Reconsideration and withdrawal of this objection are respectfully requested.

Claim Amendments

Applicant has amended the claims in order to correct minor typographical errors, and to place the claims in better form. The claim amendments are not being made in response to any statutory requirement for patentability, and have not been narrowed in scope. Instead, the claims have been amended merely to recite the subject matter therein more clearly.

Objection to the Drawings

The Examiner has objected to the drawings asserting that the drawings must show every feature of the invention specified in the claims.

In order to overcome this objection, the term "connector" has been deleted from the claims and substituted with the term "tube gripping means". Support for this amendment may be found throughout the specification and in particular on page 5, lines 27 and 28.

The term "tubing gripper" has been replaced by the term "drain gripper" in the claims. Supports for this amendment may be found on page 7, line 17 of

the specification.

Claims 16, 39, 53, 75 and 83 all recite the feature of “the guide blade extends *substantially* the same distance from the pivot joint as the other blades”, and not “the guide blade having the same length as the curved blades”, as asserted by the Examiner. This feature is clearly shown in Figs. 3 and 8 of the drawings. In addition to this, the words “forwardly from the pivot joint” have been added to the claims to remove any ambiguity from the claims.

The wording in the claim is limited so that the blades project at *approximately* the same height above the guide blade as the length of tubing, and not exactly the same height. At the top of page 7 of the original specification, the Applicant states that the drain 11 is slightly below or in line with the deepest portion of the blades 2. This ensures that the drain 11 will easily follow the channel created by the blades 2 (see page 7, lines3-6). This is also shown in the drawings. Furthermore, the use of various sizes of tubing can be readily understood by those of ordinary skill in the art.

Applicant respectfully submits that the claim amendments address each of the deficiencies pointed out by the Examiner, and negate the requirement for amended drawings. Accordingly, reconsideration and withdrawal of this objection are respectfully requested.

Specification Objection

The Examiner has objected to the specification because of several informalities. In order to overcome this objection, Applicant has amended the specification in order to correct the deficiencies pointed out by the Examiner. Particularly, the terms "forcep arm" and "bifurcated arms" have been incorporated therein. Claims 1, 20, 23, 24, 31, 43, 46, 47, 56, 59, 60, 77, 78, 85 and 86 have been amended accordingly.

Reconsideration and withdrawal of this objection are respectfully requested.

Rejection Under 35 U.S.C. § 112, 2nd Paragraph

Claims 5, 8, 10, 11-23, 24, 27, 29-46, 47-59, 64, 69, 70-76, 77-84 and 85-87 stand rejected under 35 U.S.C. § 112, 2nd Paragraph. This rejection is respectfully traversed.

The Examiner has set forth certain instances wherein the claims are indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

In order to overcome this rejection, Applicant has amended claims 5, 8, 10-13, 27, 29, 30, 35, 36, 47, 64, 67, 69-72, 77, 81 and 82 to correct each of the deficiencies specifically pointed out by the Examiner. Particularly, the term "third" has been deleted from each of these claims. Claim 36 has been amended accordingly. The term "intercostal drain" in claims 21 and 44 has been replaced

by the phrase "length of tubing". Antecedent basis for this amendment may be found in claims 1 and 31 respectively. Claim 77 has been amended in accordance with the Examiner's suggestion.

Applicant respectfully submits that the claims, as amended, particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Duplicate Claims Objection

The Examiner objected claims under 37 CFR 1.75 as being a substantial duplicate of another claim (for example, claim 2 is a duplicate of claim 24).

Applicant respectfully submits that many of the claims may appear similar in their content, however, this is entirely necessary in order to provide the best possible protection to the Applicant. Due to the recent decisions concerning amendments to specifications and, in particular, the interpretation of those amendments with regard to the scope of protection offered by a particular claim, Applicant deems it necessary to word the claims in such a manner to achieve an acceptable claim that is not subjected to considerable amendment.

The claims have been worded in such a manner so that an acceptable claim may be obtained without having to amend that claim, during prosecution, by the inclusion of additional features.

Applicant urges, therefore, the Examiner to now understand why the claims have been worded in such a manner and indeed why this was necessary. Applicant requests that the claims be allowed to stand in order to offer the best possible protection to the Applicant.

Rejection Under 35 U.S.C. § 102

Claims 1, 8, 10, 11, 12, 13, 14, 15, 16, 17, 19, 20, 23, 35, 37, 38, 39, 40, 42, 43, 46, 48, 51, 52, 53, 54, 55, 56, 59, 60, 65, 67, 70, 71, 72, 73, 74, 75, 76, 77, 78, 81, 82, 83, 84, 85 and 86 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Boughten et al. (Boughten). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

While not conceding the appropriateness of the Examiner's rejection, but merely to advance prosecution of the instant application, Applicants respectfully submit that independent claim 1 has been amended to recite a combination of elements in a scissors-like surgical forceps, including a tube gripping means for releasably securing the exterior of tubing mounted on the pivot joint, whereby the length of tubing is held spaced-apart from and rearwardly of the blades when the blades are being inserted into a patient. Claims 60 and 85 have been similarly amended. Support for the portion of the amendment to claims 1, 60 and 85 replacing the term "connector" with the phrase "tube gripping means"

may be found throughout the specification and in particular on page 5, line 11 and page 5, lines 27-28.

Applicant respectfully submits that this combination of elements as set forth in independent claims 1, 60 and 85 is not disclosed or made obvious by the prior art of record, including Boughten.

Claims 77 has been amended to recite a combination of elements in a scissors-like surgical forceps, including a guide blade mounted on the pivot joint, the guide blade extending rearwardly of the pivot joint and terminating in a bifurcated portion, each bifurcated arm of said bifurcated portion carries a drain gripper of arcuate shape, the bifurcated arms can be urged apart to receive a length of tubing and form releasable grip means.

Applicant respectfully submits that this combination of elements as set forth in independent claim 77 is not disclosed or made obvious by the prior art of record, including Boughten.

The Applicant's claimed invention relates to a scissors-like surgical forceps. By contrast, Boughten relates to a tube expanding device (not a scissors-like surgical forceps). The two devices are extremely disparate, each serving a distinct and separate function. A tube-expanding device could not, under any reasonable interpretation, be regarded as a surgical forceps.

Furthermore, Boughten does not teach the feature of "each forcep arm on one side of the pivot joint comprising a blade". The word "blade" has a very definite meaning. It is defined as a sharp instrument used for cutting or

puncturing. The blades of the Applicant's claimed invention are blades in the context of the definition because their cutting feature makes them suitable for insertion into the chest cavity (page 4, lines 7 & 8) of a patient to form a suitable aperture in the chest wall for insertion of an intercostal drain. This implies, therefore, that the blades are necessarily sharp in order to facilitate their insertion through the chest wall. By contrast, Boughten describes the arms terminating in tips 18a, 18b (column 3, lines 15 to 18 inclusive). Those "tips", with the help of tip 18c, are used to expand a tube into a triangular-like cylinder (prism), as shown in Fig. 4b, so that a cable or wire may be inserted through the expanded tube, and thereafter the tips are brought together again to leave the tube in a contracted state about the cable or wire (column 4, lines 35 to 49). The "tips" do not perform a cutting or puncturing function at any stage. These "tips" cannot therefore be considered to be blades within the meaning of the Applicant's claimed invention.

With regard to the limitation of "whereby the length of tubing is held spaced-apart from and rearwardly of the blades when the blades are being inserted into a patient", no portion of Boughten et al. describes a scissors-like surgical forceps having a "a tube gripping means for releasably securing the *exterior* of a length of tubing mounted on the pivot joint, whereby the length of tubing is held spaced-apart from and rearwardly of the blades when the blades are being inserted into a patient". This tube gripping means allows the operator of the scissors-like surgical forceps to have the tubing ready for insertion once

the appropriate channel has been made in the patient, and gives greater flexibility of movement to the operator of the device when performing the procedure. This is a major advantage of the Applicant's claimed invention in that the operator of the device will be greatly facilitated when carrying out a difficult procedure.

Therefore Boughten fails to teach including a tube gripping means for releasably securing the exterior of tubing mounted on the pivot joint, whereby the length of tubing is held spaced-apart from and rearwardly of the blades when the blades are being inserted into a patient, as recited in independent claims 1, 60 and 85 (as amended). Reconsideration and withdrawal of these art grounds of rejection are respectfully requested.

With regard to independent claim 77, the tip 18c is not, under any reasonable interpretation, a guide blade mounted on the pivot joint. The tip of Boughten does not perform a cutting or puncturing function, and nor does it (at any stage) perform a guide function of directing the two other blades in their operation. It is submitted therefore that Boughten does not disclose the feature of "a guide blade."

Particularly, Boughten fails to teach a combination of elements in a scissors-like surgical forceps, including a guide blade mounted on the pivot joint, the guide blade extending rearwardly of the pivot joint and terminating in a bifurcated portion, each bifurcated arm of said bifurcated portion carries a drain gripper of arcuate shape, the bifurcated arms can be urged apart to receive a

length of tubing and form releasable grip means, as recited in independent claim 77, as amended. Reconsideration and withdrawal of these art grounds of rejection are respectfully requested.

With regard to dependent claims 8, 10, 11, 12, 13, 14, 15, 16, 17, 19, 20, 23, 35, 37, 38, 39, 40, 42, 43, 46, 48, 51, 52, 53, 54, 55, 56, 59, 65, 67, 70, 71, 72, 73, 74, 75, 76, 78, 81, 82, 83, 84, 85 and 86, Applicant submits that claims 8, 10, 11, 12, 13, 14, 15, 16, 17, 19, 20, 23, 35, 37, 38, 39, 40, 42, 43, 46, 48, 51, 52, 53, 54, 55, 56, 59, 65, 67, 70, 71, 72, 73, 74, 75, 76, 78, 81, 82, 83, 84, 85 and 86 depend, either directly or indirectly, from independent claims 1, 60, 77 and 85, which are allowable for the reasons set forth above, and therefore claims 8, 10, 11, 12, 13, 14, 15, 16, 17, 19, 20, 23, 35, 37, 38, 39, 40, 42, 43, 46, 48, 51, 52, 53, 54, 55, 56, 59, 65, 67, 70, 71, 72, 73, 74, 75, 76, 78, 81, 82, 83, 84, 85 and 86 are allowable based on their dependence from claims 1, 60, 77 and 85. Reconsideration and allowance thereof are respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 2, 3, 4, 5, 7, 9, 18, 22, 24, 25, 26, 27, 28, 30, 31, 32, 33, 34, 41, 45, 47, 48, 49, 50, 58, 61, 62, 63, 64, 66, 67, 68, 69, 79, 80, and 87 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Boughten in view of Redmon. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Boughten, argued above with respect to independent claims 1, 60 and 85, fails to disclose or suggest a combination of elements in a scissors-like surgical forceps, including a tube gripping means for releasably securing the exterior of tubing mounted on the pivot joint, whereby the length of tubing is held spaced-apart from and rearwardly of the blades when the blades are being inserted into a patient. Independent claims 24, 31 and 47 have been similarly amended to recite this combination of elements.

Additionally, the Applicant's claimed invention relates to the field of surgical forceps. Redmon also relates to the field of surgical forceps. Boughten, however, relates to a tube expanding device for placing plastic marking sleeves on electrical cables and not to surgical forceps. Those of ordinary skill in the art of surgical forceps' design and construction would not be familiar with the Boughten device as it relates to an entirely different and disparate field. There is nothing in Boughten to suggest that such a device could be put to use as a surgical forceps, and indeed, it is obvious that not only would this not be practical, but it is obvious that such a device would be entirely unsuitable.

Those of ordinary skill in the art, even in the unlikely event that they did acquire knowledge of Boughten, would not think it obvious to combine the teachings of Boughten with those of Redmon, again because both relate to entirely different fields and have entirely separate and distinct uses. The person skilled in the art would have no motivation even to try to combine the Redmon device with the Boughten device as there is nothing in either document to

suggest that it either could or would be possible to do so or any benefits that may arise by combining the two teachings. Therefore, Boughten fails to teach or suggest a combination of elements in a scissors-like surgical forceps, including a tube gripping means for releasably securing the exterior of tubing mounted on the pivot joint, whereby the length of tubing is held spaced-apart from and rearwardly of the blades when the blades are being inserted into a patient, as recited in independent claims 24, 31 and 47 (as amended). Redmon cannot supply the deficiency of Boughten.

With regard to dependent claims 2, 3, 4, 5, 7, 9, 18, 22, 25, 26, 27, 28, 30, 32, 33, 34, 45, 47, 48, 49, 50, 58, 61, 62, 63, 64, 66, 67, 68, 69, 79, 80, and 87, Applicant submit that claims 2, 3, 4, 5, 7, 9, 18, 22, 25, 26, 27, 28, 30, 32, 33, 34, 45, 47, 48, 49, 50, 58, 61, 62, 63, 64, 66, 67, 68, 69, 79, 80, and 87 depend, either directly or indirectly, from independent claims 1, 24, 31 and 47 which are allowable for the reasons set forth above, and therefore claims 2, 3, 4, 5, 7, 9, 18, 22, 25, 26, 27, 28, 30, 32, 33, 34, 45, 47, 48, 49, 50, 58, 61, 62, 63, 64, 66, 67, 68, 69, 79, 80, and 87 are allowable based on their dependence from claims 1, 24, 31 and 47. Reconsideration and allowance thereof are respectfully requested.

Additional Cited References

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Percy L. Square, Registration No. 51,084, at (703) 205-8034, in the Washington, D.C. area.

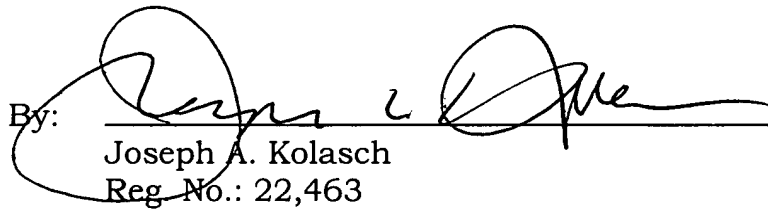
Prompt and favorable consideration of this Amendment is respectfully requested.

Applicants respectfully petition under the provisions of 37 C.F.R. § 1.136(a) and § 1.17 for a three-month extension of time in which to respond to the Examiner's Office Action. The Extension of Time Fee in the amount of **\$475.00** is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 
Joseph A. Kolasch
Reg. No.: 22,463


JAK/PLS

P.O. Box 747
Falls Church, Virginia 22040-0747
Telephone: (703)205-8000

Attachment: